

Application/Control Number: 09/769,119
Art Unit: 2655

Docket No.: 2000-0031

REMARKS

Reconsideration and allowance are requested. Applicants have cancelled claims 1 - 12, amended claim 13 and added new claims 20 - 37 for consideration.

The amendment to claim 13 is not made for patentability but to address the Examiner's objection and to improve the claim language.

Rejection of Claims 1 - 19 Under Section 103

The Examiner rejects claims 1 - 19 under Section 103 as being unpatentable over U.S. Patent No. 5,555,447 to Kotzin et al. ("Kotzin et al.") in view of U.S. Patent No. 5,216,744 to Alleyne et al. ("Alleyne et al."). Claims 1 - 12 have been cancelled and therefore, the rejection of these claims is moot.

The Examiner rejects claim 13 in view of Kotzin et al. and Alleyne et al. Applicant submits that there is no motivation nor suggestion to combine these two references and therefore, claim 13 and its depend claims are patentable and in condition for allowance.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

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If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principles outlined in both these cases are applicable here.

The Examiner states that it would have been obvious to "modify" Kotzin et al. so that the time-compression was accomplished by a time scale modification method that removed an integer number of pitch periods worth of voice signal to provide a more effective compression technique. The Examiner asserts that a pitch related approach is mentioned in Alleyne et al. Applicant respectfully submits that under the principles set forth above, there is no motivation to modify Kotzin et al. because Kotzin et al. already teach a method of compression that differs from the Alleyne et al. approach. Further, blending Kotzin et al. with Alleyne et al. would require Kotzin et al. to alter a principle of operation in their invention and thus Kotzin et al. are insufficient to render the claims obvious.

FIG. 5 of Kotzin et al. illustrates the transmission of compressed speech between time periods t_2 and t_3 . FIGs. 6 and 7 of Kotzin et al. illustrate how in a typical speech pattern, there are silent ranges (S1, S2 and S3) and speech portions (P1, P2 and P3). As explained more fully below, Kotzin et al. identify their compression method and do not leave room or suggestion to one of skill in the art to look for other compression methods.

The compression technique taught by Kotzin et al. requires a speech present detector (SPD) that removes the silent portions to time-compress the speech. Kotzin et al. state that the SPD approach is "a conventional feature with respect to the present invention." Col. 3, lines 62 - 63. Therefore, Kotzin et al. state that the SPD approach is their established and

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accepted approach for their invention. This articulated point of view must be considered when analyzing what the references teach and suggest to one of skill in the art and specifically whether one of skill in the art would seek elsewhere for a different compression technique. The Examiner must determine how the suggestive power in the reference may urge one of skill in the art to or away from other references in the obviousness analysis and whether any motivation exists to combine one reference with another. Here, there is no suggestion or language such as “other compression techniques may be used” or that the SPD approach is one of many acceptable compression approaches. Kotzin et al. require the SPD approach and note that SPDs are known to those of skill in the art and many SPD techniques are known for time assigned speech interpolation (TASI). Kotzin et al. also state that “Many such SPD techniques are known in the art of time assigned speech interpolation (TASI)”. Col. 3, lines 63 - 64. Therefore, any suggestion that does exist in Kotzin et al. is nevertheless limited to SPDs which require the detection of present speech and the removal of the silent portions of the speech. Each of these comments teaches and suggests to one of skill in the art that only acceptable compression technique is an SPD approach.

Applicant therefore submits that Kotzin et al. teach that the SPD compression method is their accepted and “conventional” compression technique for their invention. One of skill in the art would therefore have no reason or suggestion, based on the teachings of Kotzin et al., to go outside of an SPD context to modify Kotzin et al. with an alternate compression technique. Furthermore, if the Alleyne et al. approach was incorporated to “modify” Kotzin et al., then the proposed modification of Kotzin et al. would change the principle operation of their invention. The Examiner would require Kotzin et al. to jettison their “conventional feature with respect to the invention” for another compression technique. In this regard, Kotzin et al. would have to change a principle operation of their invention (SPD

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compression). When such a blending requires this kind of change in principle operation, the MPEP appropriately prevents the establishment of any motivation to combine.

For these reasons, Applicant respectfully submits that under a proper section 103 analysis, one of skill in the art would not find any motivation or suggestion to combine these references to arrive at each claim limitation. Furthermore, given the change in the principle of operation of Kotzin et al. that would be required their invention were blended with Alleyne et al., Applicant submits that the teaching of Kotzin et al. are not sufficient to render the claims *prima facie* obvious. Therefore, claim 13 and dependent claims 14 - 19 are patentable and in condition for allowance.


New claims 20 - 37 recite further variations on the invention. Applicant submits that in view of the lack of motivation or suggestion to one of skill in the art to combine these references, that new claims 20 - 37 are each patentable and in condition for allowance.

CONCLUSION

Having addressed the rejection of claims 1 - 19 and introduced new claims 20 - 37, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

Date: September 22, 2004

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